

ESTTA Tracking number: **ESTTA785867**

Filing date: **11/29/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Traditional Medicinals
Granted to Date of previous extension	11/30/2016
Address	4515 Ross Road Sebastopol, CA 95472 UNITED STATES

Correspondence information	Jeremy Johnson Traditional Medicinals, Inc. 4515 Ross Road Sebastopol, CA 95472 UNITED STATES jjohnson@tradmed.com,khuggins@tradmed.com,galbers@tradmed.com Phone:707-823-8911
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Applicant Information

Application No	86884239	Publication date	08/02/2016
Opposition Filing Date	11/29/2016	Opposition Period Ends	11/30/2016
Applicant	GALLETAS DE CALIDAD, S.A. DE C.V. Poniente 122 02630 MÃ©xico City, MEXICO		

Goods/Services Affected by Opposition

Class 030. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Biscuits; Cookies; Pastries
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Applicant Information

Application No	87060142	Publication date	11/22/2016
Opposition Filing Date	11/29/2016	Opposition Period Ends	12/22/2016
Applicant	GALLETAS DE CALIDAD, S.A. DE C.V. Poniente 122 No. 489 Col. Coltongo 02630 MÃ©xico City, MEXICO		

Goods/Services Affected by Opposition

Class 030. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Biscuits; Cookies; Pastries
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1258222	Application Date	08/12/1982
Registration Date	11/22/1983	Foreign Priority Date	NONE
Word Mark	NIGHTY NIGHT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1974/10/00 First Use In Commerce: 1976/01/05 Herbal Teas for Use as a Sleep Inducer		

U.S. Registration No.	1561220	Application Date	01/30/1989
Registration Date	10/17/1989	Foreign Priority Date	NONE
Word Mark	NIGHTY NIGHT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1974/10/00 First Use In Commerce: 1976/01/05 HERB TEA FOR FOOD PURPOSES		

U.S. Registration No.	2205033	Application Date	04/14/1997
Registration Date	11/24/1998	Foreign Priority Date	NONE
Word Mark	NIGHTY NIGHT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1974/10/00 First Use In Commerce: 1976/01/05 dietary and nutritional supplements in the nature of herb teas		


Attachments	Consolidated Opposition_Nighty Nights.pdf(393325 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address

record by First Class Mail on this date.

Signature	/Jeremy Johnson/
Name	Jeremy Johnson
Date	11/29/2016

3. Applicant is a sociedad anonima (sa de cv) organized and existing under the laws of Mexico.
4. On January 22, 2016, Applicant filed an application with the intent to use the word mark NIGHTY NIGHTS in International Class (IC) 030 for “Biscuits; Cookies; Pastries”. This trademark application was published for Opposition on August 2, 2016.
5. On June 3, 2016, Applicant filed an application with the intent to use the word and design mark  in International Class (IC) 030 for “Biscuits; Cookies; Pastries”. This trademark application was published for Opposition on November 22, 2016.

Priority

6. Applicant filed its applications to register both of its marks on an “intent to use” basis.
7. Applicant may only assert “constructive” use of Applicant’s Marks as of January 22, 2016 and June 3, 2016 respectively, several decades after Opposer adopted its NIGHTY NIGHT marks.
8. Opposer is the exclusive owner in the United States of the federally registered mark NIGHTY NIGHT in IC 005 and IC 030 (“Opposer’s Marks”) as identified below and attached in **Exhibits A-C**.

Reg. Number	Reg. Date	Trademark	IC	Goods / Services Statement
1258222	11/22/1983	NIGHTY NIGHT	5	Herb teas for use as a sleep inducer
1561220	10/17/1989	NIGHTY NIGHT	30	Herb tea for food purposes.
2205033	11/24/1998	NIGHTY NIGHT	5	Dietary and nutritional supplements in the nature of herb teas

9. Opposer’s Marks are valid and enforceable.
10. Opposer’s Marks are incontestable.
11. Since at least 1974, Opposer has used the trademark NIGHTY NIGHT throughout the United States with respect to goods in IC 005 and IC 030.

12. Opposer's NIGHTY NIGHT products are supported by significant advertising and promotional investment including in national print and digital advertising. Through its advertising and promotional efforts, Opposer's NIGHTY NIGHT marks have achieved prominence throughout the marketplace and public sphere. As a result of its widespread awareness, well-established reputation for safety, efficacy, and health and wellness, Opposer's NIGHTY NIGHT products have achieved fame and broad distribution in both brick and mortar stores, as well as online retailers.
13. Opposer's NIGHTY NIGHT products are a top-selling medicinal tea at major mass-market and grocery retailers including Wal-Mart, Target, Kroger and Whole Foods, as well as online retailers like Amazon.com.
14. Opposer has priority over Applicant and, therefore, the registration of Applicant's Marks is improper under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

Likelihood of Confusion

15. Applicant's Marks incorporate the entirety of Opposer's Marks.
16. Upon information and belief, Applicant intends to sell its products through the same channels of trade as Opposer, specifically grocery and mass market retailers, as well as online marketplaces.
17. Upon information and belief, Applicant's products, specifically biscuits, and Opposer's tea products are often served and consumed together, and are often located nearby, or even, in the same aisles at grocery stores. One of Opposer's products is specifically designed for food preparation purposes. Biscuits are a food.
18. Upon information and belief, Applicant's products are intended to be used in a similar manner, and consumed at the same time, as Opposer's (namely at night). Because Applicant's Marks are likely to cause confusion as to the source of goods, registration of the marks would be in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

Dilution by Blurring

19. Registration of Applicant's Marks is also likely to dilute the distinctiveness of the fame and reputation of Opposer's Marks by eroding consumer's exclusive identification of Opposer's Marks with Opposer, and otherwise lessening the capacity of the NIGHTY NIGHT marks to identify and distinguish Opposer's goods and services in violation of §43 of the Lanham Act, 15 U.S.C. §1125.
20. Applicant's Marks are likely to cause dilution by blurring the fame and reputation of the NIGHTY NIGHT marks based on a number of considerations including, but not limited to:
- (a) Applicant's Marks incorporate the entirety of Opposer's Marks;
 - (b) Opposer's Marks are inherently distinctive through Opposer's extensive and continuous use of its NIGHTY NIGHT marks in the United States for over 40 years;
 - (c) Opposer has engaged in substantially exclusive use of Opposer's Marks in connection with Opposer's goods; and
 - (d) Opposer's Marks are highly recognized by the general consuming public.
21. By virtue of Opposer's continuous and exclusive use, advertising, promotion, and sale of teas and dietary supplements, Opposer's NIGHTY NIGHT marks have become recognized by the relevant public as identifying products associated exclusively with Opposer.
22. Opposer's products bearing NIGHTY NIGHT marks have been offered at trade shows for at least the past three (3) decades, and are sold nationwide in major retail stores and internet retailers.
23. Opposer's Marks became famous before Applicant's constructive use of Applicant's Marks, and well before Applicant applied for registration of Applicant's Marks.

24. By eroding consumers' exclusive identification of Opposer's NIGHTY NIGHT marks with Opposer, and otherwise lessening the capacity of Opposer's Marks to identify the goods and services of Opposer, Applicant's Marks are in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

False Suggestion of a Connection

25. Applicant's Marks incorporate the entirety of Opposer's Marks.
26. The consuming public will mistakenly identify Applicant's goods and Opposer's goods as originating from the same source.
27. Opposer has no connection to Applicant or its activities.
28. Applicant's use of Applicant's Marks in connection with biscuits, cookies and pastries create a false suggestion of affiliation with, or sponsorship by, Opposer.
29. By creating a false and misleading suggestion of affiliation, Applicant's Marks are in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

Conclusion

30. The registration of the Applicant's Marks is inconsistent with Opposer's rights in its NIGHTY NIGHT marks and will cause damage to Opposer's trademarks and business.

WHEREFORE, Opposer respectfully prays that this Consolidated Opposition be sustained and that Application Serial Nos. 86/884239 and 87/060142 be refused registration.

Opposer submits herewith the requisite filing fee of \$600.00 for opposition of the two separate marks.

Dated this 29th day of November, 2016.

TRADITIONAL MEDICINALS, INC.

/Jeremy M Johnson/
Jeremy Johnson, Esq.
4515 Ross Road
Sebastopol, CA 95472-2250
Phone: 800-543-4372 / 707.823.8911
Email: jjohnson@tradmed.com

*Attorney for Opposer,
Traditional Medicinals, Inc.*

CERTIFICATE OF MAILING

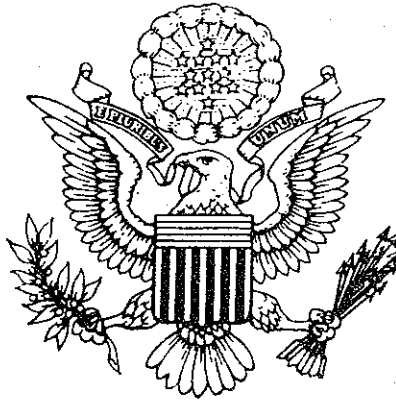
I hereby certify that a copy of the attached CONSOLIDATED NOTICE OF OPPOSITION (together with all exhibits and a copy of this Certificate) was served this 29^h day of November 2016 by US mail to:

Alumit IP
Attention: John Alumit
135 S. Jackson Street, Suite 200
Glendale, CA 91205

/Jeremy M Johnson/
Signature

Date of Signature: 29.November.2016

EXHIBIT A



Nº 1258222

THE UNITED STATES OF AMERICA

CERTIFICATE OF REGISTRATION

This is to certify that the records of the Patent and Trademark Office show that an application was filed in said Office for registration of the Mark shown herein, a copy of said Mark and pertinent data from the Application being annexed hereto and made a part hereof,

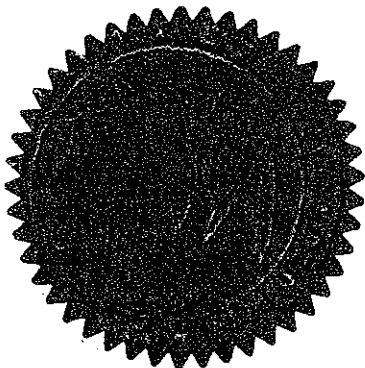
And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

Upon examination, it appeared that the applicant was entitled to have said Mark registered under the Trademark Act of 1946, and the said Mark has been duly registered this day in the Patent and Trademark Office on the

PRINCIPAL REGISTER

to the registrant named herein.

This registration shall remain in force for Twenty Years unless sooner terminated as provided by law.



In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this twenty-second day of November, 1983.

COMMISSIONER OF PATENTS AND TRADEMARKS

NOTICE

This Registration will be canceled by the Commissioner of Patents and Trademarks at the end of six years following the date of registration, unless within one year next preceding the expiration of such six years, the registrant files in the Patent and Trademark Office an affidavit showing that said mark is in use in Commerce or showing that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. A fee of \$100.00 for each class must accompany the affidavit.



UNITED STATES
PATENT AND
TRADEMARK OFFICE

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514
www.uspto.gov

REGISTRATION NO: 1258222 SERIAL NO: 73/379707 MAILING DATE: 12/01/2003
REGISTRATION DATE: 11/22/1983
MARK: NIGHTY NIGHT
REGISTRATION OWNER: TRADITIONAL MEDICINALS, INC.

CORRESPONDENCE ADDRESS:

JAY H. GELLER
JAY H GELLER, P.C.
2425 W OLYMPIC BL, WEST TOWER, STE 4000
SANTA MONICA, CA 90404

NOTICE OF ACCEPTANCE

15 U.S.C. Sec. 1058(a)(3)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

NOTICE OF RENEWAL

15 U.S.C. Sec. 1059(a)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 9 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1059.

ACCORDINGLY, THE REGISTRATION IS RENEWED.

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):
005.

WEST, JOYCE M
PARALEGAL SPECIALIST
POST-REGISTRATION DIVISION
(703)308-9500

**PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION
CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION**

ORIGINAL

REQUIREMENTS FOR MAINTAINING A FEDERAL TRADEMARK REGISTRATION

I) SECTION 8: AFFIDAVIT OF CONTINUED USE

The registration shall remain in force for 10 years, except that the registration shall be canceled for failure to file an Affidavit of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. Sec. 1058, at the end of each successive 10-year period following the date of registration.

Failure to file the Section 8 Affidavit will result in the cancellation of the registration.

II) SECTION 9: APPLICATION FOR RENEWAL

The registration shall remain in force for 10 years, subject to the provisions of Section 8, except that the registration shall expire for failure to file an Application for Renewal under Section 9 of the Trademark Act, 15 U.S.C. Sec. 1059, at the end of each successive 10-year period following the date of registration.

Failure to file the Application for Renewal will result in the expiration of the registration.

NO FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS WILL BE SENT TO THE REGISTRANT BY THE PATENT AND TRADEMARK OFFICE. IT IS RECOMMENDED THAT THE REGISTRANT CONTACT THE PATENT AND TRADEMARK OFFICE APPROXIMATELY ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.



Int. Cl.: 5

Prior U.S. Cls.: 18 and 46

United States Patent and Trademark Office

Reg. No. 1,258,222

Registered Nov. 22, 1983

TRADEMARK
Principal Register

NIGHTY NIGHT

Traditional Medicinals, Inc. (California corporation)
P.O. Box 442
Guerneville, Calif. 95446

For: HERBAL TEAS FOR USE AS A SLEEP
INDUCER, in CLASS 5 (U.S. Cls. 18 and 46).
First use Oct. 1974; in commerce Jan. 5, 1976.

Ser. No. 379,707, filed Aug. 12, 1982.

CARLA CALCAGNO, Examining Attorney

EXHIBIT B



Nº 1561220

THE UNITED STATES OF AMERICA

CERTIFICATE OF REGISTRATION

This is to certify that the records of the Patent and Trademark Office show that an application was filed in said Office for registration of the Mark shown herein, a copy of said Mark and pertinent data from the Application being annexed hereto and made a part hereof,

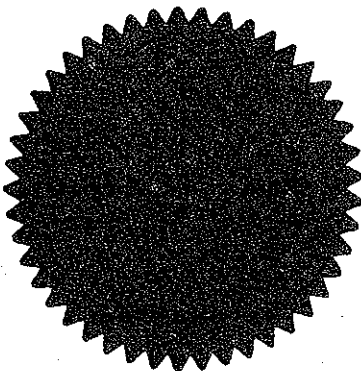
And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

Upon examination, it appeared that the applicant was entitled to have said Mark registered under the Trademark Act of 1946, and the said Mark has been duly registered this day in the Patent and Trademark Office on the

PRINCIPAL REGISTER

to the registrant named herein.

This registration shall remain in force for Twenty Years unless sooner terminated as provided by law.



In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this seventeenth day of October, 1989.

A handwritten signature in cursive script, reading "Ronald D. Ziegler".

Commissioner of Patents and Trademarks

NOTICE

This Registration will be canceled by the Commissioner of Patents and Trademarks at the end of six years following the date of registration, unless within one year next preceding the expiration of such six years, the registrant files in the Patent and Trademark Office an affidavit showing that said mark is in use in Commerce or showing that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. A fee of \$100.00 for each class must accompany the affidavit.

Int. Cl.: 30

Prior U.S. Cl.: 46

United States Patent and Trademark Office

Reg. No. 1,561,220

Registered Oct. 17, 1989

**TRADEMARK
PRINCIPAL REGISTER**

NIGHTY NIGHT

TRADITIONAL MEDICINALS, INC. (CALIFOR-
NIA CORPORATION)
4515 ROSS ROAD
SEBASTOPOL, CA 95472

FIRST USE 10-0-1974; IN COMMERCE
1-5-1976.

OWNER OF U.S. REG. NO. 1,258,222.

SER. NO. 777,640, FILED 1-30-1989.

FOR: HERB TEA FOR FOOD PURPOSES, IN
CLASS 30 (U.S. CL. 46).

HARRIET M. SINTON, EXAMINING ATTOR-
NEY

EXHIBIT C

The United States of America



CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office, that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks, and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are a part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



Bence Lehman

Commissioner of Patents and Trademarks

Maintenance Requirements

Section 8: This registration will be cancelled after six (6) years by the Commissioner of Patents and Trademarks, *UNLESS, before the end of the sixth year following the date of registration shown on this certificate*, the registrant files in the U.S. Patent and Trademark Office an affidavit of continued use as required by Section 8 of the Trademark Act of 1946, 15 U.S.C. §1058, as Amended. **It is recommended that the Registrant contact the Patent and Trademark Office approximately five years after the date shown on this registration to determine the requirements and fees for filing a Section 8 affidavit that are in effect at that time.** Currently a fee and a specimen showing how the mark is used in commerce are required for *each* international class of goods and/or services identified in the certificate of registration and both must be enclosed with the affidavit.

Section 9: This registration will expire by law after ten (10) years, *UNLESS, before the end of the tenth year following the date of registration shown on this certificate*, the registrant files in the U.S. Patent and Trademark Office an application for renewal of the registration as required by Section 9 of the Trademark Act of 1946, 15 U.S.C. §1059, as Amended. **It is recommended that the Registrant contact the Patent and Trademark Office approximately nine years after the date shown on this registration to determine the requirements and fees for filing a Section 9 application for renewal that are in effect at that time.** Currently a fee and a specimen showing how the mark is used in commerce are required for *each* international class of goods and/or services identified in the certificate of registration and both must be enclosed with the application for renewal.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

REGISTRATION NO: 2205033 SERIAL NO: 75/274095 MAILING DATE: 12/17/2007
REGISTRATION DATE: 11/24/1998
MARK: NIGHTY NIGHT
REGISTRATION OWNER: Traditional Medicinals, Inc.

CORRESPONDENCE ADDRESS:

JAY H GELLER
2425 W OLYMPIC BLVD W. TOWER, SUITE 4000
SANTA MONICA CA 90404

NOTICE OF ACCEPTANCE

15 U.S.C. Sec. 1058(a)(3)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

NOTICE OF RENEWAL

15 U.S.C. Sec. 1059(a)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 9 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1059.

ACCORDINGLY, THE REGISTRATION IS RENEWED.

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):
005.

NEWTON, DANA L
PARALEGAL SPECIALIST
POST-REGISTRATION DIVISION
571-272-9500

PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION
CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION

ORIGINAL

REQUIREMENTS FOR MAINTAINING A FEDERAL TRADEMARK REGISTRATION

I) SECTION 8: AFFIDAVIT OF CONTINUED USE

The registration shall remain in force for 10 years, except that the registration shall be canceled for failure to file an Affidavit of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. Sec. 1058, at the end of each successive 10-year period following the date of registration.

Failure to file the Section 8 Affidavit will result in the cancellation of the registration.

II) SECTION 9: APPLICATION FOR RENEWAL

The registration shall remain in force for 10 years, subject to the provisions of Section 8, except that the registration shall expire for failure to file an Application for Renewal under Section 9 of the Trademark Act, 15 U.S.C. Sec. 1059, at the end of each successive 10-year period following the date of registration.

Failure to file the Application for Renewal will result in the expiration of the registration.

NO FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS WILL BE SENT TO THE REGISTRANT BY THE PATENT AND TRADEMARK OFFICE. IT IS RECOMMENDED THAT THE REGISTRANT CONTACT THE PATENT AND TRADEMARK OFFICE APPROXIMATELY ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.

Int. Cl.: 5

Prior U.S. Cls.: 6, 18, 44, 46, 51 and 52

Reg. No. 2,205,033

United States Patent and Trademark Office

Registered Nov. 24, 1998

**TRADEMARK
PRINCIPAL REGISTER**

NIGHTY NIGHT

**TRADITIONAL MEDICINALS, INC. (CALIFOR-
NIA CORPORATION)
4515 ROSS ROAD
SEBASTOPOL, CA 95472**

**FIRST USE 10-0-1974; IN COMMERCE
1-5-1976.
OWNER OF U.S. REG. NOS. 1,258,222 AND
1,561,220.**

**FOR: DIETARY AND NUTRITIONAL SUP-
PLEMENTS IN THE NATURE OF HERB TEAS,
IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).**

**SER. NO. 75-274,095, FILED 4-14-1997.
JOHN MICHOS, EXAMINING ATTORNEY**